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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,329	04/12/2004	Knut Behnke	81760/LPK	3112
7590	12/01/2005		EXAMINER CHEN, SOPHIA S	
Lawrence P. Kessler Patent Department NexPress Solutions LLC 1447 St. Paul Street Rochester, NY 14653-7103			ART UNIT 2852	PAPER NUMBER
DATE MAILED: 12/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

472

Office Action Summary

Application No.

10/822,329

Applicant(s)

BEHNKE ET AL.

Examiner

Sophia S. Chen

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-13 is/are rejected.
- 7) ☒ Claim(s) 3, 4 and 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/26/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 5 is objected to because of the following informalities:

- a. Line 1, "(1)" should be deleted.
- b. Line 2, "(3)" and "(5)" should be deleted.
- c. Line 3, "(10)" should be deleted.

Appropriate correction is required.

Claim Rejections – 35 USC §102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Uehara et al. (US Pat. Pub. No. US 2004/0057741 A1)

Uehara et al. discloses a method and a fusing device 10 for a printing press, having a heating device (a heating roller) 2 for heating a toner 26 on a print material 24, comprising: a cooling device 38, and a control unit 30 for adjustably cooling a print image wherein the gloss of the print image is adjusted (paragraphs [0139], [0211], and [0217]).

Uehara et al. also discloses a toner 26' used is heated prior to the cooling procedure (at cooling device 38) from about 80°C to 140°C, but preferably from 110°C to 135°C (110 to 150 degrees; paragraph [0090] and Figure 1).

Claim Rejections – 35 USC §103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uehara et al. in view of Ting et al. (US Pat. No. 6,403,273 B1)

Uehara et al., as discussed above, differs from the instant claimed invention in not disclosing the toner includes 1% to 30% (5% to 25%, 10% or 20%, or 15% to 25%) aliphatic hydrocarbons, aliphatic acids, aliphatic alcohols or their salts or olefinic

Art Unit: 2852

hydrocarbons; the toner includes at least resin, particularly a polyester resin; the toner includes at least a pigment or a dyestuff; the toner includes at least a material for forming an electrical charge; and the toner contains at least a flow expedient or a solvent.

Ting et al. discloses a toner comprising 1.5% to 20% aliphatic hydrocarbons (column 3, lines 50-54), polyester resin (column 6, Table 2, last item), at least a pigment (column 3, lines 61-62), at least a material for forming an electrical charge (column 4, lines 3-5), and a flow expedient (hydrophobically treated fumed silica; column 4, lines 56-59; this can be proved by Kawata et al., US Pat. No. 6,130,018).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the toner as taught by Ting et al. in place of the toner of Uehara et al. to exhibit good fuse grade (Ting et al., column 2, lines 6-7).

Allowable Subject Matter

7. Claims 3, 4, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fukumoto et al. (US Pat. No. 4,533,614) discloses a toner comprising aliphatic acid, polyester resin, and charge control agents.

Britto et al. (US Pat. No. 5,099,288) discloses a method and device for adjusting a gloss for a print image, comprising adjusting the gloss of a print image by adjusting the cooling of the print image.

Nagayama et al. (US Pat. No. 5,164,782) discloses a method and device for adjusting a gloss for a print image, comprising adjusting the gloss of a print image by adjusting the cooling of the print image.

Elsermans et al. (US Pat. No. 5,805,969) discloses an image forming apparatus comprising a fusing station; cold air fans; and a developer containing a mixture of a resin, a pigment, and a charge controlling compound.

Kawata et al. (US Pat. No. 6,130,018) discloses a toner having a flow improver (hydrophobic vapor deposition silica).

Maekawa et al. (US Pat. Pub. No. US 2001/0051704 A1) discloses a toner comprising a polyester resin, aliphatic acid, charge control agent, colorant, and fluidizing agent.

Serizawa et al. (US Pat. Pub. No. US 2003/0027073 A1) discloses a toner comprising a polyester resin, aliphatic acid, charge control agent, colorant, and additives.

Matsumura et al. (US Pat. Pub. No. US 2004/0132920 A1) discloses a resin composition for toner exhibiting excellent low temperature fixation performance.

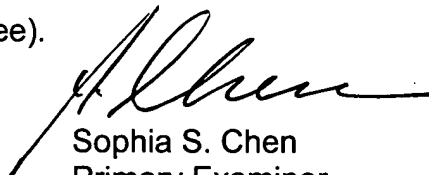
Fuma (JP 2004-085882 A) discloses an image forming apparatus comprising a cooling roller being able to bring into contact with a fixing member at a low glossiness mode and separated from the fixing member at a high glossiness mode.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sophia S. Chen whose telephone number is (571) 272-2133. The examiner can normally be reached on M-F (7:00-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sophia S. Chen
Primary Examiner
Art Unit 2852

Ssc
November 28, 2005